

REMARKS

Claim 67 has been newly canceled. Claims 27, 42 and 49 have been newly amended. As a result of these amendments, claims 27-37, 42-51, 53-63, 68 and 73 are currently pending.

The Final Office Action mailed March 23, 2004 has been carefully reviewed and the foregoing amendments are made in response thereto. Applicants thank the Examiner for indicating that claims 31-32 have been allowed and for providing clear guidance as to the issues which remain in regards to the other pending claims.

In view of the claim amendments and the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of all of the pending claims.

Response to rejections under 35 U.S.C. § 112, first paragraph

Claims 42-47 and 49-51 remain rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for claims limited to the modification of starch composition in plants transformed with potato class A starch branching enzymes, allegedly “does not reasonably provide enablement for claims broadly drawn to the modification of any other plant characteristic including height or disease resistance.”

While not acquiescing to the rejection and in an effort to further prosecution, Applicants have newly amended independent claim 42 to “[A] method of altering the **starch** characteristics of a plant...” Furthermore, claim 49 has been amended to also refer to “**starch** characteristics altered by the method of claim 42...” Each of the other claims included in this rejection (*i.e.*, claims 43-47 and 50-51) directly or ultimately depend from claim 42 and do not require further amendment. The Examiner is respectfully requested to withdraw the rejection in view of these amendments.

Claims 27-30, 33-37, 42-51, 53-63, 68 and 73 are rejected under 35 U.S.C. § 112, first paragraph, as purportedly failing to comply with the written description requirement. The Office Action states that while the specification provides support for a “1200 bp fragment of the potato class A SBE gene” that it “does not mention 400 contiguous amino acids”.

While not acquiescing to the rejection and in an effort to further prosecution, Applicants have newly amended independent claim 27 to “a 1200 bp fragment of a potato class A starch

branching enzyme (SBE) gene”. All of the other claims included in this rejected depend directly or ultimately from claim 27. The Examiner is respectfully requested to withdraw the rejection in view of this amendment.

Response to rejections under 35 U.S.C. §§ 102(e) and 102(b)

Claim 67 has been rejected over various “prior art” documents under 35 U.S.C. §§ 102(e) and 102(b) due to the allegedly broad scope of the previously-pending claims.

While not acquiescing to the rejection and in an effort to further prosecution, Applicants have newly canceled claim 67. The Examiner is respectfully requested to withdraw the rejections in view of this amendment.

Conclusion

In view of the foregoing remarks, Applicants respectfully request withdrawal of all outstanding rejections and early notice of allowance to that effect. Should the Examiner believe that a telephonic interview would expedite prosecution and allowance of this application, she is encouraged to contact the undersigned at her convenience.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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